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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/017,111	12/14/2001	William R. Matz	01372	6465
38516	7590	12/16/2008	EXAMINER	
AT&T Legal Department			ALVAREZ, RAQUEL	
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Bedminster, NJ 07921			3688	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	10/017,111	MATZ ET AL.
	<b>Examiner</b>	<b>Art Unit</b>
	Raquel Alvarez	3688

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) Responsive to communication(s) filed on 28 August 2008.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) Claim(s) 1-4,6-15 and 18-38 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-4,6-15 and 18-38 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/ are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

1. This action is responsive to the Board of Patent Appeals and Interferences decision mailed 8/28/2008 which reversed the Examiner's rejection of claims 1-4, 6-15, 18-38.

### Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Based on Supreme Court precedent<sup>1</sup> and recent Federal Circuit decisions, a 101 process must (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing.<sup>2</sup> If either of these requirements is met by the claim, the method is non a patent eligible process under § 101 and should be rejected as being directed to non-statutory subject matter.

3. **Claims 1 and 15 are** rejected under 35 U.S.C. 101 as drawn to a non-statutory subject matter. Although a machine is positively recited in the claims, there is only nominal recitation of the machine's performance in the claims.

4. **Claim 38** is rejected under 35 U.S.C. 101 as drawn to a non-statutory subject matter. The applicant is reciting only method steps such as "defining...receiving...classifying", the applicant has not recited an apparatus or device

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to perform these limitations and without apparatus or device these limitations are just mental steps. Mentioning computer in the preamble is not enough, if the body of the claims each of the steps can be performed manually.

In claim 38 the steps are related to a mental process, which is not patentable. Indeed, it is not tied to another statutory class or does not change or switch statutory class (such as a particular apparatus or physical module or device) or does not transform the underlying subject matter (such as an article or materials) to a different state or thing. See MPEP §2106.IV.B: *Determine Whether the Claimed Invention Falls Within An Enumerated Statutory Category.*

Examiner suggests applicant inserts a device in one or more steps of the body of the claims in order to overcome this rejection.

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<sup>1</sup> Diamond v. Diehr, 450 U.S. 175, 184 (1981); Parker v. Flook, 437 U.S. 584, 588 n.9 (1978); Gottschalk v. Benson, 409 U.S. 63, 70 (1972); Cochrane v. Deener, 94 U.S. 780, 787-88 (1876).

<sup>2</sup> The supreme court recognized that this test is not necessary fixed or permanent and may evolve with technological advances. Gottschalk v. Benson, 409 U.S. 63,71 (1972)

### Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. Claims 1-4, 6-15, 18-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Williams (2002/0049631 hereinafter Williams ) in view of Knudson et al. (WO 99/45702 hereinafter Knudson).

With respect to claims 1-4, 6-7, 9, 12-13, 15, 19, 21, 24, 27, 30-31, 34 and 38, Williams, teaches a method for marketing Abstract). Defining a match between a user classification and an incentive (i.e. database 48 stores electronic incentive offers stored in association with unique customer identifications)(paragraph 33); receiving from a set-top box user data associated with a user's television viewing (i.e. sending from a set-top box user television viewing information to a central location)(paragraph 35); receiving the user's credit card purchases describing purchases from retail stores POS(see Figure 1); classifying the user in a user classification when the user's television viewing relate to the user's purchases from the retail stores and transmitting the incentive to the user if a match is defined between the user classification and the incentive (i.e. redeemable electronic coupon incentives embedded on the television program identifying a product and offered based on advertisements viewed are stored in the database 48 and the system correlate database 48 with purchase data in order to match the coupons)(paragraphs 36-37).

Williams teaches classifying the user based on advertisements watched on TV. Williams doesn't specifically teach the television viewing being user's selections such as channel watched and the amount of time the channel is watched. Knudson teaches classifying a user based on channel watched, the volume watched and the time of day and days of the week and days of month watched (i.e. if a user watches sports channel,

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the user is classified as being athletic and therefore will receive advertisements related to athletic shoes)(page 29, lines 11 to page 30, lines 1-6). It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included in Williams 1, the teachings of Knudson of the user TV viewing being selected by the users such channel watched and the amount of time the channel is watched in order to monitored user's channels selections and classify the user based on his or her intended choice.

With respect to claims 8, 11, 18, 20 and 23, Williams further teaches whether a product associated with the incentive was purchased (i.e. further benefits or incentives are provided to the user based on obtained purchase data and advertisements selected)(paragraphs 35 and 37).

Claims 10, 22 further recites that the user data comprises survey data. Official notice is taken that is old and well known in marketing to ask consumers questions about their likes and dislikes and to record the answers to those questions in order to better target the users based on their answers. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included survey data in order to obtain the above mentioned advantage.

Claims 14, 26, 28 further recite that the incentive comprises a banner/ a video program. Official Notice is taken that banners are well known form of a graphic image that runs across the top, bottom, or side margin of a Web page and also for the incentive to be via a video program in order to attract viewers. It would have been obvious to a person of ordinary skill in the art in the system of Williams for the incentive to have comprised a banner or a video program in order to attract the user to the incentive.

Claim 25, 29 further recites that the viewing selections comprises video games. Official Notice is taken that it is old and well known for users to select video games on their video games such as part of Comcast ® subscribers. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included viewing selections comprises video games in order to attract younger viewers.

Claim 32 further recites identifying the incentive by demographic. Official Notice is taken that it is old and well known to issue discounts based on demographic. For example, issuing a computer coupons for households making more than \$50,000 yearly in order to increase the likelihood that the coupon will be redeemed. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included identifying the incentive by demographic in order to achieve the above mentioned advantage.

Claim 33 further recites transmitting the incentive to the user by mail. Official notice is taken that it is old and well known to provide incentives to the user by mail. For example, advertisements are old and well known to be sent to the users by mail in order to cast a large group of people. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included transmitting the incentive to the user by mail in order to obtain the above mentioned advantage.

Claim 35 further recites receiving records related to a shopping card in which the user is given a discount in exchange for using the shopping card. Official notice is taken that it is old and well known in marketing to give incentives or discount to the user to motive them to use a preferred method of payment or the like. For example, Macy's department stores have been giving a discount to their customers if they make purchases with their Macy's card for many years. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included receiving records related to a shopping card in which the user is given a discount in exchange for using the shopping card in order to obtain the above mentioned advantage.

Claims 36-37 further recite receiving a separate identification codes identifying each user of a common user terminal. Official notice is taken that it old and well known to use codes or passwords to identify each user of a common terminal. For example, Microsoft XP interface allows each user of a common terminal to enter a password in

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order to identify each of the user of the system. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included receiving a separate identification codes identifying each user of a common user terminal in order to distinguish one user from the other user of the same terminal.

***Conclusion***

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Raquel Alvarez whose telephone number is (571)272-6715. The examiner can normally be reached on 9:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James w. Myhre can be reached on (571)272-6722. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

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/Raquel Alvarez/  
Primary Examiner, Art Unit 3688  
12/9/2008

Raquel Alvarez  
Primary Examiner  
Art Unit 3688

WYNN W. COGGINS  
TECHNOLOGY CENTER DIRECTOR

